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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUSNU M. KALKANOGLU and
ROBERT L. JENKINS

Appeal 2009-012095
Application 10/807,018
Technology Center 1700

Oral Hearing Held: April 13, 2010

Before EDWARD C. KIMLIN, TERRY J. OWENS, and
PETER F. KRATZ, Administrative Patent Judges.

ON BEHALF OF THE APPELLANTS:

JOHN F. McNULTY
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1 The above-entitled matter came on for hearing on
2 Tuesday, April 13, 2010, commencing at 2:42 p.m., at the U.S. Patent
3 and Trademark Office, 600 Dulany Street, Alexandria, Virginia,
4 before Lori B. Allen, Notary Public.

5 MR. McNULTY: Good afternoon, Judge.

6 JUDGE KIMLIN: Good afternoon, Mr. McNulty.

7 MR. McNULTY: May I present Alex Plache, house
8 patent counsel for CertainTeed Corporation, the owner of the patent
9 application today, and Dr. Gregory Jacobs, also a representative of
10 CertainTeed.

11 JUDGE KIMLIN: Welcome. Our reporter today is Lori
12 Allen.

13 MR. McNULTY: I'm sorry?

14 JUDGE KIMLIN: Our reporter today is Lori Allen. If
15 you have a business card for her, she would appreciate it.

16 MR. McNULTY: Sure.

17 JUDGE KIMLIN: And we have two examiners with us in
18 the proceedings today.

19 MR. McNULTY: Okay.

20 JUDGE KIMLIN: And you can begin when you're ready.

21 MR. McNULTY: Okay. If I may, a few words about
22 shingle development over the years. Many years ago, roofing shingles
23 were all made of natural materials, thatched roofs or cedar shakes or
24 tiles. And then about, oh, a little more than 80 years ago, asphalt
25 shingles began to be made, because they're much more cost-effective
26 to manufacture. And originally, asphalt shingles were made by

1 dipping an organic or inorganic web in a vault of asphalt and then
2 moving it along a parallel longitudinal path and dropping granules on
3 the top surface, and they adhered to -- when the asphalt dried, they
4 adhered to it. A lot of the original shingles were what we would call
5 one tab; that is, they were maybe three-foot long, and were not broken
6 up. And when they were put on a roof they didn't have the look that
7 the natural materials had had, like slates or cedar shakes that were
8 individual, maybe so wide, one from another.

9 So about 80 years ago, one of the first innovations was to
10 put slots partway up the shingles, about halfway up, in the part of the
11 shingle that would be weather-exposed in the installed condition on a
12 roof, and the next course of shingles applied over top of that would
13 have its tabs covered by -- pardon me, the headlap portion would be
14 covered by the tabs of the next course of shingles. Then all the
15 players in the field, the major players -- Owens Corning, GAF,
16 CertainTeed Corporation, IKO, and some others -- began to take little
17 steps to make shingles appear increasingly more like natural shingles,
18 natural materials.

19 Some of these steps were to -- if they wanted them to
20 appear like tiles, they'd put in a border underneath or a horizontal
21 stripe to simulate greater thickness of the shingle, so that when
22 viewed from ground level, street level, the shingles looked
23 increasingly richer and richer. One of the innovations over the years
24 was to apply granules of different color to add some character to the
25 shingles. So you'd have portions of the shingles that would have

1 different-colored granules applied. And that's where we are
2 in the -- may I approach?

3 JUDGE KIMLIN: Sure.

4 MR. McNULTY: Just for quick reference -- set of the
5 drawings of the current application. Sorry. Did I disconnect
6 anything?

7 JUDGE KIMLIN: Hopefully, not.

8 MR. McNULTY: Okay. So in Figure 1 we represent
9 the -- an elongated piece of shingle moving in a horizontal direction.
10 It's already had the asphalt applied to it prior to Figure 1, and now it's
11 moving rightward under a series of hoppers, and the hoppers will have
12 different-colored granules. Well, typically, the rightmost hopper may
13 have gray granules with, let's say, a red color granule mixed in it. The
14 next one will have gray granules with a different color, let's say green,
15 mixed in with it. And the third one may have a third color. And what
16 that produces, if you look in planned view in Figure 2, because when
17 the bottoms of the hoppers are opened and granules are allowed to
18 drop out of a hopper, the hopper bottoms are closed at some point, and
19 then the second hopper bottom is opened, allowing granules to drop.

20 Now because these drops of granules have some spray or
21 spread to them, there are always transition areas where you will have
22 shingles from one hopper and shingles from another hopper before
23 you get to only shingles, let's say, of the second hopper. And for
24 example, in Figure 2, the rightmost hatched area there, let's say it
25 would have gray granules with a mixture of red granules in it, and the
26 second layer, second hatched area, B, would have perhaps, let's say,

1 gray granules with a mixture of green granules in it. And in the
2 intervening area, designated B-A, you'd have a mixture of granules
3 from the first hopper and from the second hopper.

4 Starting out on the right side of that B-A zone, let's say,
5 you'd have a greater density of red-colored granules, and as you
6 moved to the left you'd pass a point where there was an even density
7 of red and green granules, and then you'd have an increasingly greater
8 density of just the green-colored granules.

9 Now what this invention is is cutting out the entire
10 transition area when the slots are made, so that you have an
11 increasingly natural look of a separate -- a seemingly separate slate, if
12 you will, on the rightmost tab, a separate slate of a different aesthetic
13 color, for example, in the next tab and so on.

14 JUDGE OWENS: Your Claim 5 says completely
15 removing said intermediate areas?

16 MR. McNULTY: That's correct.

17 JUDGE OWENS: But Claim 3 says each intermediate
18 area being a given width, completely removing said given width of
19 intermediate areas. Does that mean that the given width can be less
20 than the entire width of the intermediate area?

21 MR. McNULTY: No.

22 JUDGE OWENS: What's the difference, then, in the
23 scope of given width --

24 MR. McNULTY: The --

1 JUDGE OWENS: You're completely removing said given
2 width of intermediate areas and completely removing said
3 intermediate areas. Is there any difference in scope between --

4 MR. McNULTY: There's not intended to be any
5 difference. In fact, while Claims 1, 3, and 5, each of the independent
6 claims, are worded somewhat differently, they're worded -- essentially
7 aimed at the same thing. It's the entirety of the intermediate areas that
8 are being removed in each of those claims.

9 And what that does is as light is reflected on different
10 areas to the extent that there are different colors, they're -- the entirety
11 of a given area is of one color, making it look like a given piece of
12 slate that was dug out of the ground. And the second one will look
13 different than that over the entirety of its area. And each one will
14 reflect photons of light in a different manner, depending upon the
15 color that makes up the dropped granules.

16 Now may I approach again? That's a cut piece of what the
17 end result looks like. In this case a backing layer, a laminate is
18 applied, and that typically would be black or it could be any color, but
19 it further enhances the difference between the two layers, making
20 them look like entirely different slates, if you will. So when the next
21 layer is applied over the top of it, that's what you see. In fact, I don't
22 know if the pictures that we filed came up to you. This is a -- one of
23 the exhibits that's in the record.

24 Now the rejection in this case is a Section 103 rejection
25 over Koschitzky. Koschitzky repeatedly and repeatedly emphasizes
26 that some portion of the intermediate area is left on each side to

1 achieve whatever aesthetic Koschitzky wanted to achieve. But it
2 obviously is very important to Koschitzky to have some portion of the
3 intermediate areas on each side of the slot, because over and over
4 again he emphasizes it and puts it in the claims.

5 JUDGE OWENS: At column 7, line 15 the reference
6 says, "Even if each slot 76 does not cover the entire width of the
7 transition area." Doesn't that indicate that it can cover the entire width
8 of the transition area?

9 MR. McNULTY: I think not. If you read that in the
10 context of the entire -- every place in here that he's talking about, I
11 think what he's saying is you don't take out the entirety of the area,
12 which is the same thing as saying you leave some of the transition
13 area on each side of the slot.

14 JUDGE KIMLIN: But the rejection is not under Section
15 102, is it?

16 MR. McNULTY: It is not.

17 JUDGE KIMLIN: So why wouldn't it have been obvious
18 to take as much of the transition area out as you want, based upon the
19 aesthetic --

20 MR. McNULTY: Over Koschitzky? Why wouldn't it
21 have been obvious over Koschitzky? Because Koschitzky teaches
22 over and over and over again --

23 JUDGE KIMLIN: Well, the question, maybe more
24 appropriately, is why wouldn't one of ordinary skill in the art, in
25 viewing Koschitzky, see that it's certainly an option to take the entire
26 intermediate area out?

1 MR. McNULTY: Well, they haven't, and --

2 JUDGE KIMLIN: No, they haven't. It's not a -- the
3 reference does not explicitly say so. The question is would it have
4 been obvious to one of ordinary skill in the art upon viewing that
5 teaching of removing the intermediate area to have it a matter of
6 obviousness to remove some of it or all of it?

7 MR. McNULTY: As I said, apparently it has not been.
8 And we have evidence of record, Declaration under rule 132
9 that -- that it was not considered obvious to a person of ordinary skill
10 in this art, from a knowledgeable person -- granted, an employee of
11 CertainTeed -- but someone who has been around in the shingle art for
12 many, many years.

13 JUDGE KIMLIN: What was the reason that the
14 conclusion was reached that it wouldn't have been obvious?

15 MR. McNULTY: One of the reasons in his Declaration
16 was based on commercial success. And the rest -- the other was his
17 judgment from knowing what the level of skill in the art is of -- in this
18 art.

19 JUDGE KIMLIN: So in his opinion, one of ordinary skill
20 in the art, looking at that reference --

21 MR. McNULTY: That is correct.

22 JUDGE KIMLIN: -- wouldn't have envisioned removing
23 the entire intermediate portion.

24 MR. McNULTY: That is correct.

25 JUDGE KIMLIN: Even if the reference said, even if the
26 entire --

1 MR. McNULTY: Right. And Mr. Snyder, the Declarant
2 in that case, was familiar with Koschitzky. I would point out
3 Koschitzky is an officer or owner, I forget -- or the president of IKO.
4 IKO has been around for a long time, making shingles. And -- well,
5 anyway.

6 JUDGE OWENS: What they are claiming and disclosing
7 in most of the references you mentioned is that you can get a clear
8 demarcation even if you don't remove the entire transition area.

9 MR. McNULTY: Well --

10 JUDGE OWENS: Why wouldn't that indicate that you
11 would still get a clear demarcation if you removed the whole
12 transition area -- you don't have to remove the whole --

13 MR. McNULTY: I submit Koschitzky had some idea of
14 what visual effect he was looking for.

15 JUDGE OWENS: We don't know that. We don't know
16 whether they're limiting it to part of the transition area because of that
17 or because someone else was removing the whole area. We just don't
18 know.

19 MR. McNULTY: Nobody else was removing the whole
20 area, to my knowledge.

21 JUDGE KIMLIN: Did you say Mr. Koschitzky was -- is
22 an employee of the assignee?

23 MR. McNULTY: No, no. As shown at the top of the
24 Koschitzky patent, the assignee there is IKO Industries. That
25 assignee, I'm saying he's, I believe, president or owner of the
26 company. I just forget. But he's -- it's a high level position in that

1 company. And obviously, he was looking for a certain effect that
2 gave him some of the color mix from one side -- from one tab on the
3 other tab, and in each case.

4 JUDGE KIMLIN: But what troubles me is that the whole
5 idea of whether he removes some of it or part of it isn't that directed to
6 the ultimate aesthetics of the resulting product, rather than its utility.

7 MR. McNULTY: It is directed to aesthetics, but the --

8 JUDGE KIMLIN: And isn't that normally a matter of
9 choice, of what you desire, what you think is pleasing to you
10 aesthetically? Or not?

11 MR. McNULTY: Well, it's more than that. Removing the
12 entirety allows the entire tab to look like a different piece of tile or a
13 different slate than the next adjacent tab, and because of the way light
14 would be reflected in a different way, because it's hitting granules of a
15 different color. And so it certainly has an aesthetic end result, but it
16 produces that function, also, that it would reflect light in different
17 ways, depending upon the makeup of each tab being different, but it
18 will be uniform throughout the entirety of any given tab.

19 JUDGE KIMLIN: So would it be fair to say that the
20 reference teaches removal of 90 percent of the overlap --

21 MR. McNULTY: No, it does not. It suggests 50 percent.

22 JUDGE KIMLIN: Fifty percent.

23 MR. McNULTY: Pardon me. It doesn't suggest 50
24 percent. I misspoke. It suggests removing that small part where it is a
25 50/50 distribution of, let's say, red granules with green granules, by, as
26 I laid out in my Brief if you try to get an idea of what it's teaching,

1 and you take it from the drawings, it looks like it removes about
2 one-third.

3 JUDGE OWENS: Assuming the drawing is to scale.

4 MR. McNULTY: It was the only thing we had to deal
5 with. And on the issue of aesthetics, yes, the invention here does
6 produce an aesthetic effect, but it produces a function that I indicated.
7 And all the players in this field that I've mentioned, and others, have
8 been making changes in asphalt shingles to produce different aesthetic
9 effects, mostly to make them look more and more like natural
10 materials, tiles, slate, cedar shakes. And --

11 JUDGE KIMLIN: And is each change in aesthetics
12 patentable, in your opinion?

13 MR. McNULTY: Yes, I do. I think so. But there's more
14 than that here. As I say, you -- it does produce a different reflection
15 of light photons.

16 JUDGE KIMLIN: But isn't that a matter of aesthetics? It
17 sounds a lot like aesthetics, how does light reflect.

18 MR. McNULTY: It becomes aesthetic, yes.

19 JUDGE KIMLIN: And it's not like you're redirecting the
20 reflection of the light to perform some function.

21 MR. McNULTY: It produces an aesthetic in the eyes of
22 viewers. No question about it. But, you know, I -- perhaps you've
23 seen. I've submitted a -- in conjunction with Mr. Snyder's deposition,
24 a book of 51 patents that were all granted because they produced
25 aesthetic things. Koschitzky was granted because it -- he's producing

1 an aesthetic thing. And, you know, if it's sauce for the goose, it ought
2 to be sauce for the gander.

3 JUDGE KIMLIN: Took the words right out of my mouth.

4 MR. McNULTY: Thank you.

5 JUDGE KIMLIN: I have no further questions.

6 MR. McNULTY: In -- based -- in that last several
7 minutes of comments, I -- you're aware of my position on In re Seid, I
8 can tell. And there isn't actually a rejection over In re Seid. The
9 rejection is over Koschitzky. In re Seid is sort of thrown in at the end
10 of the rejection by way of saying, well, if it's only ornamental, we
11 shouldn't pay too much attention to it. But the Patent Office has been
12 paying attention to it for years, and I've been doing this for 35 years,
13 and gotten lots of patents, dealt with a lot of other patents of the
14 competitors. And structural changes, functional changes that have as
15 a result, that produce an aesthetic that makes the product more
16 saleable, customers like better, they're the sorts of innovations that
17 have been patented over the years.

18 And that completes my presentation. I'd be very happy to
19 take any questions you have.

20 JUDGE KIMLIN: We have no further questions.

21 MR. McNULTY: Okay.

22 JUDGE KIMLIN: Thank you for coming.

23 MR. McNULTY: Thank you.

24 Whereupon, at 3:04 p.m., the proceedings were concluded.

25

26